

IN THE CLAIMS: See Listing of Claims. This listing will replace all prior versions of claims in the application.

REMARKS

The Applicants acknowledge the Examiner's comprehensive Office Action with appreciation. Claims 31-60 remain pending in the application. The Office raises rejections under 35 USC § 112, first and second paragraphs. The Office also raises a rejection under 35 USC § 102.

Claims 53-60 are rejected for lack of enablement under 35 USC § 112, first paragraph. It is the position of the Office that the specification, while being enabling for treating amnesia, does not reasonably provide enablement for treating or alleviating deficiencies of memory associated with cerebral aging or neurodegenerative diseases. It is the position of the Office that the instant specification only demonstrates that the instant compounds will have utility in treating amnesia, based on the activity of the instant compounds in the Morris water maze test (Example B) as well as their mnemocognitive effects (Examples C and D). It is the further position of the Office that there is no correlation between the disclosed assays and treatment of deficiencies of memory associated with cerebral aging and/or neurodegenerative diseases.

The Office acknowledges that the specification provides support for treating amnesia. The Office also acknowledges that the mnemocognitive effects of the instant compounds are demonstrated by Examples C and D at pages 20-21 of the instant specification. Therefore, with the instant Amendment, Claim 53 has been amended to limit the conditions claimed to be treatable to amnesia and deficiencies of memory. Thus, the Applicants submit that the instant invention is enabled with respect to the treatment of the specific conditions claimed.

Moreover, with the instant Amendment, pharmaceutical composition Claims 54 and 60 have been amended to delete the functional language "useful for treating deficiencies..." and "for use in the treatment of deficiencies...", respectively, since

such functional language is not considered by the Office to have any patentable relevance in pharmaceutical composition claims.

Therefore, reconsideration and withdrawal of the lack of enablement rejection is respectfully requested.

Claims 53-55, 57, and 60 are rejected for indefiniteness under 35 USC § 112, second paragraph.

It is the position of the Office that the phrase "neurodegenerative diseases including Alzheimer's disease, Parkinson's disease..." in Claims 53-55 and 60 is indefinite because the definition of "neurodegenerative diseases" is not clear. With the instant Amendment, the phrase "neurodegenerative diseases including Alzheimer's disease, Parkinson's disease..." has been deleted from the claims.

It is the position of the Office that the term "alleviation" in Claims 53 and 55 is indefinite because the degree of alleviation is not defined and it is not clear how such alleviation is assessed. With the instant Amendment, Claims 53 and 55 have been amended to replace the term "alleviation" with "treatment."

It is the position of the Office that the phrase "including a human" in Claims 53 and 55 is indefinite because it represents a subgeneric phrase included within a generic phrase. With the instant Amendment, the phrase "including a human" has been deleted from Claims 53 and 55 and new method Claims 61 and 62, directed to treating a human and which are dependent on Claims 53 and 55, respectively, have been added.

It is the position of the Office that the term "sinomenine compound" in Claims 55, 57, and 60 is vague and unclear. With the instant Amendment, the term "sinomenine and/or a sinomenine compound" in Claims 55 and 60 has been replaced with "a compound of formula (Ia)." Support for this amendment may be found in the instant specification at pages 9-10. Claims 57 and 58 have been cancelled as they are redundant on amended Claim 55.

Reconsideration and withdrawal of the indefiniteness rejections is respectfully requested.

Claims 31-33, 36, 38-41, 44 and 52 are rejected under 35 USC § 102(b) as being anticipated by Iijima, et al. (*J. Med. Chem.*, **1978**, 21, 1320-1322). It is the position of the Office that compounds **1**, **2**, and **3** of Iijima, et al. anticipate the instantly claimed compounds when R₂ represents hydrogen, and both R₃ and R₄ and R₅ and R₆ together form oxo or one of R₃ and R₄ or R₅ and R₆ forms oxo and either R₃ or R₆ represents alkoxy.

The Applicants respectfully submit that compound **2** of Iijima, et al. is specifically excluded from the instant claim scope by the proviso in Claim 1 which states that "the compound of formula (I) may not represent 1-bromo-4-hydroxy-3,7-dimethoxy-17-methyl-7,8-didehydromorphinan-6-one." Moreover, with the instant Amendment, Claim 1 has been amended to recite "R₃ and R₄ together form oxo when X is fluorine, chlorine or iodine, or =N-OR₈ (wherein R₈ represents hydrogen or alkyl)." Therefore, compounds **1** and **3** of Iijima, et al. are not encompassed by the instant claim scope. Reconsideration and withdrawal of the rejection under 35 USC § 102(b) is respectfully requested.

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Accordingly, entry of present amendment, reconsideration of all grounds of objection and rejection, withdrawal thereof, and passage of this application to issue are all hereby respectfully solicited.

It should be apparent that the undersigned agent has made an earnest effort to place this application into condition for immediate allowance. If she can be of assistance to the Examiner in the elimination of any possibly-outstanding insignificant impediment to an immediate allowance, the Examiner is respectfully invited to call her at her below-listed number for such purpose.

Allowance is solicited.

Respectfully submitted,

THE FIRM OF HUESCHEN AND SAGE

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Enclosure: Listing of Claims, Check No. 74752 for Two (2) Month Extension Fee,
and Postal Card Receipt

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